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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/692,090	10/23/2003	Shigeru Nemoto	WAKAB60.001DV5	8325

20995 7590 05/19/2006

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EXAMINER
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DESANTO, MATTHEW F

ART UNIT	PAPER NUMBER
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3763

DATE MAILED: 05/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/692,090

Applicant(s)

NEMOTO, SHIGERU

Examiner

Matthew F. DeSanto

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 March 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4 and 9-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 9-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/21/06, 4/25/06</u> | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Objections***

1. The claim objection drawn to claim 9 is withdrawn.

### ***Claim Rejections - 35 USC § 112***

2. The 112 Rejection has been withdrawn because of the remarks by the applicant, which provided the specific page and line numbers that supported the claimed range.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-4, 9-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Botich et al. (USPN 5,407,431), and further in view of Ericson et al. (US Pub 20010014996 A1).

The examiner would like to clarify his interpretation of the claims prior to his rejection.

With regards to claim 2 & 4, the examiner is interpreting "for use in an injection apparatus" to be intended use of the syringe barrel. The examiner is also interprets "said syringe barrel adapted to be mounted on a cylinder holder that comprises a flange insertion groove" to be functionally language because the syringe barrel only needs to be capable of being mounted in a cylinder holder with a flange groove which the prior art is capable of since the prior art has a flange that is capable of being inserted into a

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flange groove. The examiner would further make mention that the last statement in claims 2 and 4 is also functional language because of the "said flange adapted to be held by said flange insertion groove," therefore the prior art only needs to be capable of performing this functional. The claims 2 and 4 never positively recite the cylinder holder and only functionally describe this device.

Botich et al. discloses a pre-filled syringe (Col. 11, lines 14-24) with a syringe barrel comprising a flange that has a front and rear surface, wherein the front surface is roughened (Col. 11, lines 14-24, see figure 1) "to provide a greater coefficient of friction". The grooves (83) have a regular patterned of roughness since each groove is roughened and the roughness has a convex and concave pitch over the front surface of the flange because of the valleys and ridges that are formed by the grooves (83). Botich et al. fails to disclose "wherein the cross section of the roughened surface has a roughness of about No. 20 to 1500 as expressed in terms of count of sand paper" and "wherein at least one of the front and rear surface is randomly roughened".

Ericson et al. discloses a wedge clamp type termination for elevator tension members, but more importantly Ericson et al. teaches using sandblasting to raise the coefficient of friction of a surface (paragraph [0036]). Ericson et al. further teaches other methods of increasing the surface friction, which include etching, machining, knurling and other suitable equivalents.

Therefore, at the time of the invention it would have been obvious to use sandblasting as another means of roughening the front surface of the flange to create a

greater coefficient of friction between the fingers and thumb because it is well known that there are many methods that can be used to increase surface friction as taught by Ericson et al. By using this method of increasing the coefficient of friction, the cross section of the roughened surface having a roughness of about No. 20 to 1500 as expressed in terms of count of sand paper would be an obvious modification since the range lacks any criticality or special feature and thus such a range would have been obvious to one skilled in the art wishing for a particular roughness and friction.

The examiner would also like to note that by using sandblasting, it would cause random roughening because sand is being blasted into the object, thus causing the sand to be randomly placed into the object due to the force being exerted on the sand, thus creating a random pattern after each injection. This pattern can be controlled and follow a regular pattern if this method is used to form sections of roughened areas, thus creating a regular pattern from the roughened areas. Ericson et al. also teaches the formation of small ridges and valleys, which further supports the fact that the roughened section will have a convex and concave pitch (paragraph [0036]).

### ***Response to Arguments***

5. Applicant's arguments filed 3/23/06 have been fully considered and are persuasive.

6. The 102 rejections in view of Reilly et al. (USPN 5,997,502), Nolan, JR, et al. (US Pub 2001/0023336) and Wimmer have been withdrawn due to the amendment to the claims.

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7. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew F. DeSanto whose telephone number is 571-272-4957. The examiner can normally be reached on Monday-Friday 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nick LUCCHESI can be reached on (571) 272-4977. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Matthew DeSanto  
Art Unit 3763  
May 11, 2006